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KNOBLE & YOSHIDA, LLC			BRADEN, SHAWN M	
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GEORGE J. TARULIS

Appeal 2009-003556
Application 10/706,370
Technology Center 3700

Decided: August 10, 2009

Before DONALD E. ADAMS, DEMETRA J. MILLS, and ERIC GRIMES,
Administrative Patent Judges.

MILLS, *Administrative Patent Judge.*

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 from the Examiner's final rejection of claims 1, 3, 4, 22 and 23. The Examiner has rejected the claims for obviousness. We have jurisdiction under 35 U.S.C. § 6(b).

STATEMENT OF CASE

The claims are directed to packaging for foodstuffs, in particular, a tin-coated can for packaging light colored fruits and vegetables that require an exposed tin surface to maintain proper coloration.

The field of canmaking is generally subdivided into two-piece cans and their related technology, and the same as that for three-piece cans. A two-piece can is characterized by a bottom end that is unitary with the sidewall of the can, and a separate top end that is secured to the sidewall. Most of the cans in which soft drinks are packaged today are two-piece drawn wall ironed (DWI) cans. On the other hand, a three-piece can is characterized by a sidewall portion and a separate top and bottom end that are fastened to the can body, usually by a double seaming process.

(Spec. 1:15-20.)

The claims on appeal read as follows:

1. A DWI can for packaging light colored fruits and vegetables, comprising:

a bottom;

a sidewall integral with said bottom, said sidewall comprising a steel substrate, a first coating comprising tin on an outer surface thereof and a second unbreached, intact coating comprising tin on an inner surface thereof, said second unbreached, intact coating having a mass per unit area that is at least 0.20 pounds of tin per base box, said sidewall further comprising no additional protective coating on said unbreached, intact second coating; and

a top end secured to said sidewall,

wherein said sidewall is fabricated by a drawn wall ironing process from a tin coated steel substrate.

3. A DWI can according to claim 1, wherein said second coating has a mass per unit area that is at least 0.25 pounds of tin per base box.

4. A DWI can according to claim 1, wherein said second coating is thicker than said first coating.
22. A DWI can containing a light colored fruit or vegetable, comprising:
 - a DWI can having a bottom;
 - a sidewall integral with said bottom, said sidewall comprising:
 - a steel substrate;
 - a first coating on an outer surface of said sidewall, said first coating comprising tin and having a first thickness; and
 - a second unbreached, intact coating on an inner surface of said sidewall that defines an internal space of said DWI can, said second unbreached, intact coating having a second thickness that is greater than said first thickness and comprises tin, said second unbreached, intact coating having a mass per unit area that is at least 0.20 pounds of tin per base box, said sidewall further comprising no additional protective coating on said second coating;
 - a top end secured to said sidewall; and
 - a light colored fruit or vegetable disposed within said internal space of said DWI can.
23. A DWI can according to claim 22, wherein said second coating has a mass per unit area that is at least 0.25 pounds of tin per base box.

Cited References

Peters	US 4,095,544	June 20, 1978
Zenger	US 4,466,553	Aug. 21, 1984

Ground of Rejection

Claims 1, 3, 4, 22 and 23 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Peters in view of Zenger. Appellant separately argues claims 1, 3, 4, 22 and 23. (Br. 4-8.) We address each of these claims separately.

ISSUE

The Examiner finds that the combination of Peters and Zenger discloses each element claimed and concludes that it “would have been obvious to one having ordinary skill in the art at the time the invention was made to add a vegetable and a lid to the container of Peters, as taught by Zenger, in order to keep vegetables fresh in storage” (Answer 4).

Appellant contends that Peters does not disclose what the pounds of tin per base box of the sidewalls are after the can is made (App. Br. 5). Further, “Peters does not disclose having no additional coating on the unbreached, intact second coating” (*id.*).

The Issue is: Has Appellant demonstrated error in the Examiner’s obviousness rejection?

FINDINGS OF FACT

1. Specification, Fig. 4 is reproduced below.

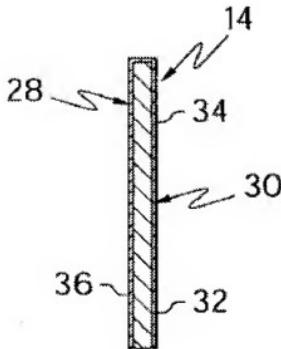


FIG. 4

Fig. 4 shows a DWI can body with

exterior tin coating 34 and the second, interior tin coating 36, . . . [where] both coatings, and in particular the second interior thicker coating 36, remain unbreached and intact. The second coating 36 of tin material that is on the interior surface 28 is preferably attached to the substrate 32 of the sidewall 14 at a mass per unit area that is at least 0.15 pounds of tin per base box (a thickness that is commonly referred to in the industry as "30 pounds" per base box stock thickness). More preferably, the second coating 36 has a mass per unit area density of at least 0.20 pounds per base box.

(Spec. 5.)

2. Peters discloses

a bottom (17) a sidewall (19) integral with said bottom, said sidewall comprising a steel substrate (20), a first coating comprising tin (24) on an outer surface thereof, and a second unbreached[,] intact coating (22) comprising tin on an inner surface thereof, said second unbreached, intact coating having a mass per unit area that is at least 0.20 pounds of tin per base

box (col. 2, ln. 44), said sidewall further comprising no additional protective coating on said unbreached, intact second coating.

(Ans. 3.)

3. Peters, Fig. 1 is reproduced below.

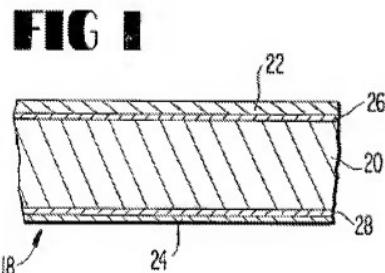


Fig. 1 shows a steel substrate (20), a first coating of electrolytically deposited tin (24) on one surface thereof, and a second coating (22) of electrolytically deposited tin on the other surface thereof. (Peters, col. 2, ll. 35-53.) The Examiner finds that coating 22 is on the inner surface and coating 24 is on the outer surface (Ans. 3).

4. Peters discloses said second coating which has a mass per unit area that is at least .25 pounds of tin per base box (col. 2, l. 44). Peters also discloses the second coating (22) which is thicker than the first coating (24) (col. 2, ll. 43-45). However, Peters does not disclose a top end and a light colored fruit or vegetable. (Ans. 3-4.)

5. Peters discloses that layer 22 (second coating) in Fig. 1 can have a coating weight of $\frac{3}{4}$ (.75) pound per basebox, and layer 24 (first coating) can

have a coating weight of, for example ¼ (.25) pound per basebox. (Peters, col. 2, ll. 35-45.)

5. Zenger teaches a top end (52) and a vegetable such as green beans (col. 11, l. 46) in the same field of endeavor for the purpose of packaging vegetables. (Ans. 4.)
6. The Examiner concludes that it would have been obvious to one having ordinary skill in the art at the time the invention was made to add a vegetable and a lid to the container of Peters, as taught by Zenger, in order to keep vegetables fresh in storage. (Ans. 4.)
7. In Peters, drawn sidewalls are “subjected to a further but different type of plastic flow of the metal in each wall thinning action as the sidewalls pass each successive ironing ring. For practical reasons the thinning of the sidewalls is not shown in the drawings.” (Col. 3, ll. 58-63.)

PRINCIPLES OF LAW

“In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a *prima facie* case of obviousness.” (Citations omitted.) *In re Rijckaert*, 9 F.3d 1531, 1532 (Fed. Cir. 1993). Only if that burden is met, does the burden of coming forward with evidence or argument shift to the applicant. In order to determine whether a *prima facie* case of obviousness has been established, we consider the factors set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1996): (1) the scope and content of the prior art; (2) the differences between the prior art and the claims at issue; (3) the level of ordinary skill in the relevant art; and (4) objective evidence of nonobviousness, if present.

“[W]hen the question is whether a patent claiming the combination of elements of prior art is obvious” the relevant inquiry is “whether the improvement is more than the predictable use of prior art elements according to their established functions.” *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 417 (2007).

Where . . . the claimed and prior art products are identical or substantially identical, or are produced by identical or substantially identical processes, the PTO can require an applicant to prove that the prior art products do not necessarily or inherently possess the characteristics of his claimed product.... Whether the rejection is based on “inherency” under 35 U.S.C. § 102, on “prima facie obviousness” under 35 U.S.C. § 103, jointly or alternatively, the burden of proof is the same, and its fairness is evidenced by the PTO’s inability to manufacture products or to obtain and compare prior art products.

In re Best, 562 F.2d 1252, 1255 (CCPA 1977) (emphasis added).

“‘Comprising’ is a term of art used in claim language which means that the named elements are essential, but other elements may be added and still form a construct within the scope of the claim.” *Genentech, Inc. v. Chiron Corp.*, 112 F.3d 495, 501 (Fed. Cir. 1997).

ANALYSIS

Appellant contends that “Peters does not disclose having no additional coating on the unbreached, intact second coating.” (App. Br. 5.) Further, Appellant argues that Peters does not disclose what the pounds of tin per base box of the sidewalls are after the can is made. (*Id.*)

Claim 1

We are not persuaded by Appellant's argument. We essentially agree with the Examiner's reasoning, fact finding, and response to Appellant's arguments as set forth in the Answer, and adopt them as our own. We provide the following additional comment.

With respect to Appellant's argument that "Peters does not disclose having no additional coating on the unbreached, intact second coating" we find no error in the Examiner's analysis that layers 26 and 28 of Fig. 1 of Peters are considered part of the substrate and are not excluded from the interpretation of the broad claims before us, as the claims include the transitional language "comprising" which does not exclude the presence of other layers.

Regarding the failure of Peters to disclose the pounds of tin per base box of the sidewalls after the can is made, we find that claim 1 requires the inner can surface to have a mass per unit area that is at least 0.20 pounds of tin per base box. The Examiner finds that Peters' tin coating (24) is on an outer surface of the can and coating (22) is on an inner surface of the can. (FF2.) Appellant has not provided any basis for concluding that the Examiner's finding is in error.

Peters discloses inner surface layer 22 can have a coating weight of $\frac{3}{4}$ (.75) pound per basebox (FF5). Even though Peters discloses that this layer is subjected to thinning in the manufacturing process (FF7), we conclude that one of ordinary skill in the art would have expected that, even after thinning, inner surface layer 22 would have a coating weight of at least 0.20 pounds of tin per base box, as claimed, since it starts out at 0.75 pounds per

base box. Thus, under the principles of *In re Best*, the burden shifted to Appellant to show that the inner layer of Peters would not have been understood by one of ordinary skill in the art to be at least 0.20 pounds of tin per base box, as claimed. Appellant has provided no evidence of this nature. The rejection of claim 1 is affirmed.

Claims 3, 23

For the same reasons discussed above with regard to claim 1, we conclude that one of ordinary skill in the art would have expected that, even after thinning, inner surface layer 22 would have a coating weight of at least 0.25 pounds of tin per base box, as claimed, since it starts out at 0.75 pounds per base box. Thus, under the principles of *In re Best*, the burden shifted to Appellant to show that the inner layer of Peters would not have been understood by one of ordinary skill in the art to be at least 0.25 pounds of tin per base box, as claimed in claims 3 and 23. Appellant has provided no evidence of this nature.

The rejection of claims 3 and 23 is affirmed.

Claim 4

Claim 4 recites a DWI can according to claim 1, wherein said second coating is thicker than said first coating.

Peters discloses layer 22 (second coating) can have a coating weight of $\frac{3}{4}$ (.75) pound per basebox, and layer 24 (first coating) can have a coating weight of, for example $\frac{1}{4}$ (.25) pound per basebox. (Peters, col. 2, ll. 35-45; FF 5.)

The rejection of claim 4 is affirmed.

Claim 22

Claim 22 is essentially the same as claim 1 and incorporates the limitation of claim 4. For the reasons discussed herein with respect to claims 1 and 4, we affirm the rejection of claim 22.

CONCLUSION OF LAW

The rejection of claims 1, 3, 4, 22 and 23 under 35 U.S.C. § 103(a) as unpatentable over Peters in view of Zenger is affirmed.

TIME PERIOD FOR RESPONSE

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED

clj

KNOBLE & YOSHIDA, LLC
EIGHT PENN CENTER
SUITE 1350
1628 JOHN F. KENNEDY BLVD.
PHILADELPHIA, PA 19103